

Applicant: Samuel Steinemann  
Serial No.: 10/750,446  
Filing Date: December 31, 2003  
Docket No.: 1409-2 RCE/CON/RCE  
Page 4

**REMARKS**

Applicant and its representatives wish to thank Examiner Combs-Morillo for her courtesy in taking the time to grant a telephone interview with the undersigned on July 14, 2006. Although an agreement was not reached with regard to the allowability of the claims, the Examiner did indicate that she would look favorably upon a comparison of the tensile strength between the alloy of the invention and that disclosed in GB 1,035,879 ('879 patent).

Claim 11 has been amended and Claim 12 has been cancelled. Accordingly, Claims 11 and 13-21 remain pending. In view of the amendments and remarks set forth below, reconsideration is respectfully requested.

First, Applicant has incorporated the limitations set forth in dependent Claim 12, into independent Claim 11. More specifically, the recited steps include subsequently cold processing the alloy.

In addition, Claim 11 now includes the limitation of the alloy having a tensile strength of at least 769 MPa. Support for this limitation can be found, for example, in Table 2 on page 7 of the application. 769 MPa corresponds to 78.438 kg/mm<sup>2</sup>. This value is significantly higher than the value of 70 kg/mm<sup>2</sup> of the Ti15Zr disclosed in the '879 patent. Accordingly, one skilled in the art, relying upon the '879 patent, would use alloys having a Zr content greater than 35% by weight in order to have the strength necessary to be used for the production of a surgical implant. This amount of zirconium taught by the '879 patent is well outside of the claimed range of between 5 and 25% by weight.

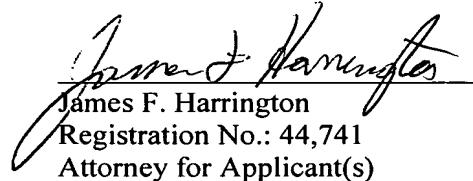
It is well settled that, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claimed limitations. It is respectfully submitted that the cited references do not teach all of the claimed limitations as set forth in Claim 11 as amended or any of the claims dependent thereon.

Accordingly, Applicant respectfully submits that the application is now in proper form for allowance, which action is earnestly solicited. If resolution of any remaining issue

Applicant: Samuel Steinemann  
Serial No.: 10/750,446  
Filing Date: December 31, 2003  
Docket No.: 1409-2 RCE/CON/RCE  
Page 5

is required prior to allowance of the application, it is respectfully requested that the Examiner contact Applicant's attorney at the telephone provided below.

Respectfully submitted,

  
James F. Harrington  
Registration No.: 44,741  
Attorney for Applicant(s)

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550  
JFH/jp

225402\_1